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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SHUJI OTSUKA

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04/21/2004

OLIFF & BERRIDGE, PLC  
P.O. BOX 19928  
ALEXANDRIA, VA 22320

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 04/21/2004

20

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/237,896

Applicant(s)

OTSUKA ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6-16,19,21-28 and 31-47 is/are pending in the application.
- 4a) Of the above claim(s) 38-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8 and 11-14 is/are rejected.
- 7) ☒ Claim(s) 9,10,15,16,19,21-28,31-37 and 47 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>20</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                              |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____.  |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment was received on 1/29/04, and has been entered and made of record. Currently, **claims 1-3, 6-16, 19, 21-28, and 31-47** are pending, wherein **claims 38-46** are withdrawn for being drawn to a non-elected invention.

### *Response to Arguments*

2. Applicant's arguments, filed 1/29/04, with respect to the rejection of independent **claim 1** have been fully considered but they are not persuasive. However, in view of applicant's arguments and the interpretation of claim 1, which is discussed below, the examiner withdraws the rejections of dependent **claims 15 and 26**, along with the directly or indirectly dependent **claims 16, 19, 21-28, and 31-37**, as the examiner believes that these claims now include allowable subject matter. While the examiner understands applicant's arguments, after consideration, the examiner believes that the reference of Ogata (U.S. Patent Number 5,283,665) can still be interpreted as anticipating claim 1, as currently worded.

3. Particularly, in response to applicant's arguments regarding the rejection of **claim 1**, cited in the Office action dated 8/8/03 as being anticipated by Ogata, whereby on pages 13-16 applicant argues that because Ogata teaches of shutting down the communication line when compared data does not agree, Ogata fails to teach of receiving a transfer command specifying a memory box in accordance with a box number, whereby when the memory box specified by the transfer command is effective, the device *transmits* first image data stored in the memory box to

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a calling side facsimile device, and when the memory box is ineffective, the facsimile device *transmits* second image data different from the first image data to the calling side facsimile device.

4. Currently, claim 1 requires “an image transfer device for **transferring** the first image data stored in the specified by the transfer command is effective, and alternatively for **transferring** second image data different from the first image data to the calling side when the judgment device judges that the memory box specified by the transfer command is ineffective”.

While the terms “transferring” and “transmitting” can have similar meanings, the examiner notes that the term “transferring” can also have a meaning that differs with that of “transmitting”.

Specifically, as defined in Merriam Webster’s Collegiate Dictionary, tenth edition, the term “transfer” has one meaning defined as “to convey from one person, place, or situation to another”. Thus, claim 1 requires transferring (or conveying) second image data different from the first image data to the calling side when the memory box specified by the transfer command is judged ineffective. As read in column 10, lines 58 through 61, and seen in Fig. 12B, upon the receiving device discriminating a shutdown of the communication line, a message is displayed stating that print-out is not permitted. Thus, by the transmitting device shutting down communication, as seen in Fig. 11B at S614, Ogata is effectively conveying second image data to the calling side, which is displayed as a message. Because of the current claim language, the examiner believes that this interpretation of “transferring” with regard to the second image data is correct, since the claim does not specify that the second image data is actually stored in the facsimile device, thereby having the second image data that is stored in the facsimile device sent to the calling device, as suggested by applicant.

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5. Using this interpretation, one of ordinary skill in the art can recognize that Ogata teaches of a detection device for detecting a transfer command arrived to the facsimile device (steps S602 and S608, in Figs. 11A and 11B, column 11, lines 1 through 26, wherein the transfer command is the “confidential mail transmission request” made by the receiving device), the transfer command specifying a memory box in accordance with the box number and instructing transfer of the first image data stored in the specified memory box to a calling side (column 11, lines 3 through 11), a judgment device for judging whether or not the memory box specified by the transfer command using the box number detected by the detection device is effective (steps 609 and 610, column 11, lines 11 through 16), and an image transfer device for transferring the first image data stored in the specified by the transfer command is effective (“yes” in step S610, being step S611, column 11, lines 15 through 24), and alternatively for transferring second image data different from the first image data to the calling side when the judgement device judges that the memory box specified by the transfer command is ineffective (“no” in step S610, being step S614, column 11, lines 24 through 26, whereby as read in column 10, lines 58 through 61, when the shutdown of the communication is discriminated at the receiving device, being the calling side, a message is displayed therein stating that print-out is not permitted, thus, effectively “transferring” second image data to the calling side).

6. Continuing, in response to applicant’s arguments on page 14, which state the Ogata fails to specifically teach of a box corresponding to the bulletin board box. The examiner notes that claim 1 specifies “the memory box includes plurality of confidential boxes and bulletin board boxes”. As read in column 5, lines 35 through 45, the image memory 106 is “used as a mailbox or confidential mailbox”. Thus, as seen in Figs. 1 and 2, the image memory 106 and 206 include

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a mailbox, which is interpreted as a "bulletin board box", and include a confidential mailbox, which is interpreted as "the confidential box". Further, as read on column 1, lines 34 through 42, a password is used to distinguish confidential mail in the confidential mailbox, and is not used for mail in the mailbox, thereby allowing various recipients to view or print the image data, thus effectively being a bulletin board box.

7. Therefore, the rejection of **claim 1**, as cited in the Office action dated 8/8/03, under 35 U.S.C. 102(b), as being anticipated by Ogata, is maintained and repeated in this Office action. Further, for the same reasons discussed above, the rejections of dependent **claims 2, 3, 6-8, and 11-14**, are maintained and repeated in this Office action.

#### ***Claim Objections***

8. The objection of **claim 33**, as cited in the Office action dated 8/8/03, is overcome by the changes set forth in the amendment dated 1/29/04.

#### ***Claim Rejections - 35 USC § 102***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. **Claims 1-3, 6-8, and 11** are rejected under 35 U.S.C. 102(b) as being anticipated by Ogata (U.S. Patent Number 5,283,665, cited in the Office action dated 8/8/03).

Regarding **claim 1**, Ogata discloses a facsimile device (see abstract, and Figs. 1 and 2) including an image data memory for storing image data (image memory 106 and 206), a plurality of memory boxes provided in the image data memory (see Figs. 1 and 2), each of the memory

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boxes being accompanied with a predetermined box number and storing first image data therein (column 9, lines 48 through 66), a detection device for detecting a transfer command arrived to the facsimile device (steps S602 and S608, in Figs. 11A and 11B, column 11, lines 1 through 26, wherein the transfer command is the “confidential mail transmission request” made by the receiving device), the transfer command specifying a memory box in accordance with the box number and instructing transfer of the first image data stored in the specified memory box to a calling side (column 11, lines 3 through 11), a judgment device for judging whether or not the memory box specified by the transfer command using the box number detected by the detection device is effective (steps 609 and 610, column 11, lines 11 through 16), and an image transfer device for transferring the first image data stored in the specified by the transfer command is effective (“yes” in step S610, being step S611, column 11, lines 15 through 24), and alternatively for transferring second image data different from the first image data to the calling side when the judgement device judges that the memory box specified by the transfer command is ineffective (“no” in step S610, being step S614, column 11, lines 24 through 26, whereby as read in column 10, lines 58 through 61, when the shutdown of the communication is discriminated at the receiving device, being the calling side, a message is displayed therein stating that print-out is not permitted, thus, effectively “transferring” second image data to the calling side), wherein the memory box includes plurality of confidential boxes and bulletin board boxes (see Figs. 1 and 2), and wherein each of the confidential boxes is accompanied with the box number and an identification number (column 1, lines 19 through 45, and column 10, lines 38 through 68, and column 13, lines 42 through 62), and each of the bulletin board boxes is accompanied with only the box number (column 1, lines 19 through 45, and column 14, lines 31 through 34).

Regarding **claim 2**, Ogata discloses the device discussed above in claim 1, and further teaches that the judgement device judges whether or not the memory box corresponding to the box number specified by the transfer command exists (see Fig. 11B, steps 609 and 610, column 11, lines 11 through 16) and judges that designation of the memory box specified by the transfer command is effective when the memory box corresponding to the box number specified by the transfer command exists (“yes” in step S610, being step S611, column 11, lines 15 through 24) and that the designation of the memory box specified by the transfer command is ineffective when the memory box corresponding to the box number specified by the transfer command does not exist (“no” in step S610, being step S614, column 11, lines 24 through 26).

Regarding **claim 3**, Ogata discloses the device discussed above in claim 2, and further teaches that the judgement device judges that the memory box corresponding to the box number specified by the transfer command does not exist, the image transfer device transfers the second image data to the calling side (“no” in step S610, being step S614, column 11, lines 24 through 26, whereby as read in column 10, lines 58 through 61, when the shutdown of the communication is discriminated at the receiving device, being the calling side, a message is displayed therein stating that print-out is not permitted, thus, effectively “transferring” second image data to the calling side).

Regarding **claim 6**, Ogata discloses the device discussed above in claim 1, and further teaches that the transfer command includes information of the box number and the identification number corresponding to the confidential box and a telephone number of the calling side (column 11, lines 1 through 26, and column 13, lines 42 through 62), and information of the box



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number corresponding to the bulletin board box and a telephone number of the calling side (column 11, lines 1 through 26, and column 13, line 42 through column 14, line 34).

Regarding *claim 7*, Ogata discloses the device discussed above in claim 6, and further teaches that the judgement device judges whether or not the identification number assigned to the confidential box coincides with the identification number included in the transfer command when the box number specified by the transfer command coincides with the box number of the confidential box (column 11, lines 1 through 26, and column 13, line 42 through column 14, line 11).

Regarding *claim 8*, Ogata discloses the device discussed above in claim 7, and further teaches that the image transfer device transfers the second image data to the calling side when the judgement device judges that the identification number assigned to the confidential box does not coincide with the identification number included in the transfer command (“no” in step S610, being step S614, column 11, lines 24 through 26, whereby as read in column 10, lines 58 through 61, when the shutdown of the communication is discriminated at the receiving device, being the calling side, a message is displayed therein stating that print-out is not permitted, thus, effectively “transferring” second image data to the calling side).

Regarding *claim 11*, Ogata discloses the device discussed above in claim 1, and further teaches that the judgement device judges that the memory box accompanied with the box number specified by the transfer command stores no image data, the image transfer device transfers the second image data to the calling side (column 11, lines 1 through 26, and column 14, lines 1 through 30).

***Claim Rejections - 35 USC § 103***

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. **Claims 12-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogata (U.S. Patent Number 5,283,665, cited in the Office action dated 8/8/03) in view of Mori *et al.* (U.S. Patent Number 5,727,050, cited in the Office action dated 8/8/03).

Regarding **claim 12**, Ogata discloses the device discussed above in claim 1, but fails to expressly disclose if the second image data is image data indicating an operation manual.

Mori discloses a facsimile device (see abstract, and Fig. 1) including an image data memory for storing image data (image memory 18, column 3, lines 4 through 20), a plurality of memory boxes provided in the image data memory (mailboxes 18a/18b/..., column 3, lines 1 through 20, see Fig. 1), each of the memory boxes being accompanied with a predetermined box number and storing first image data therein (column 3, lines 16 through 20), a detection device for detecting a transfer command arrived to the facsimile device (column 6, lines 40 through 59), the transfer command specifying a memory box in accordance with the box number and instructing transfer of the first image data stored in the specified memory box to a calling side (column 6, line 40 through column 7, line 4), a judgment device for judging whether or not the memory box specified by the transfer command using the box number detected by the detection device is effective (column 5, line 66 through column 6, line 59), and an image transfer device for transferring the first image data stored in the specified memory box when the transfer command is effective (column 6, lines 46 through column 7, line 4), and alternatively for transferring second data different from the first image data to the calling side when the

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judgement device judges that the memory box specified by the transfer command is ineffective (column 7, lines 5 through 29), wherein the memory box includes plurality of confidential boxes and bulletin board boxes, and wherein each of the confidential boxes is accompanied with the box number and an identification number (column 3, lines 25 through 46), and each of the bulletin board boxes is accompanied with only the box number (column 7, lines 31 through 41). Further, Mori teaches that the second data is data indicating an operation manual (column 5, line 47 through column 6, line 21, and column 7, lines 5 through 20).

Ogata & Mori are combinable because they both are from the same field of endeavor, being facsimile machines having confidential mailboxes.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Mori in the system of Ogata, thereby having the second image data indicating an operation manual.

The suggestion/motivation for doing so would have been that Ogata's system would become more user-friendly with the addition of Mori's teachings, as the user would be informed of a procedure of operation of the system, therein making the system easier to use.

Therefore, it would have been obvious to combine the teachings of Mori with the system of Ogata to obtain the invention as specified in claim 12.

Regarding *claim 13*, Ogata and Mori disclose the device discussed above in claim 12, and Mori further teaches that the data of the operation manual includes at least a method of specifying the box number and the identification number (column 5, line 47 through column 6, line 39, and column 7, lines 5 through 20).

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Therefore, as discussed above, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Mori's teachings in the system of Ogata, thereby having the second image data is image data indicating an operation manual.

The suggestion/motivation for doing so would have been that Ogata's system would become more user-friendly with the addition of Mori's teachings, as the user would be informed of a procedure of operation of the system, therein making the system easier to use.

Therefore, it would have been obvious to combine the teachings of Mori with the system of Ogata to obtain the invention as specified in claim 13.

Regarding *claim 14*, Ogata and Mori disclose the device discussed above in claim 13, and Mori further teaches that the data of the operation manual includes at least information registered in each of the memory boxes (see Fig. 4, column 5, line 47 through column 6, line 39, and column 7, lines 5 through 20).

Therefore, as discussed above, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Mori's teachings in the system of Ogata, thereby having the second image data is image data indicating an operation manual.

The suggestion/motivation for doing so would have been that Ogata's system would become more user-friendly with the addition of Mori's teachings, as the user would be informed of a procedure of operation of the system, therein making the system easier to use.

Therefore, it would have been obvious to combine the teachings of Mori with the system of Ogata to obtain the invention as specified in claim 14.

***Allowable Subject Matter***

13. **Claims 9, 10, 15, 16, 19, 21-28, 31-37, and 47** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding **claim 9**, the examiner finds no teaching in the prior art that has a system with an effective number of digits of the box number for the confidential box being set to three, an effective number of the identification number for the confidential box being set to four, and an effective number of the box number for the bulletin board box being set to two.

Regarding **claim 15**, after considering applicant's arguments dated 1/29/04, the examiner believes that it would not have been obvious to have the second image data stored in a memory box specified by advance from among the memory boxes, with the image transfer device transferring the second image data stored in the specified memory box to the calling side when the judgment device judges that the designation of memory box specified by the transfer command is ineffective.

Regarding **claim 26**, after considering applicant's arguments dated 1/29/04, the examiner believes that it would not have been obvious to have a message data memory for storing in advance a plurality of message data, a transfer data setting device for choosing a first message data from the message data memory, the first message data indicating that designation of the memory box number is ineffective, when the judgment judges that the designation of the memory box specified by the transfer command is ineffective, and for setting transfer data in accordance with the chosen first message data.

***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph R. Pokrzywa  
Examiner  
Art Unit 2622

jrj



EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600